

## **REMARKS**

### **Summary of the Final Office Action**

Claims 11-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik (U.S. Patent No. 6,865,551 B1) (hereinafter "Stefik") in view of an article by Kaplan ("IBM Cryptolopes, Superdistribution and Digital Rights Management") (hereinafter "Kaplan").

### **Summary of the Response to the Office Action**

Applicant has amended independent claim 11 to differently describe embodiments of the disclosure of the instant application's specification. Accordingly, claims 11-15 currently remain pending for consideration.

### **Rejections under 35 U.S.C. § 103(a)**

Claims 11-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik in view of Kaplan. The Office Action concedes, at page 4, that Stefik "does not disclose transmitting an order to the information distribution server and an input/output request to the storage server through the network." However, the Office Action then applies Kaplan as allegedly curing these deficiencies of Stefik.

Applicant has amended independent claim 11 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Newly-amended independent claim 11 of the instant application describes a combination of features of a user device that can be connected through a network to a digital information distribution system including a database for storing digital contents information, an information distribution server for distributing the digital contents information in the database, and a storage server for storing the digital contents information thus distributed.

The user device of newly-amended independent claim 11 includes “a communication unit for transmitting an order by a contents user of obtaining the digital contents information to the information distribution server and an input/output request to the storage server through the network, to make the information distribution server attach duplicate-time limit information to the digital contents information and send the digital contents information with the duplicate-time limit information to a dedicated storage provided in the storage server and allocated exclusively for the contents user for storing digital contents information thus ordered and obtained, and further make the dedicated storage hold the digital contents information with the duplicate-time limit information and input and output the digital contents information in accordance with the duplicate-time limit information on the basis of the input/output request.” The user device of newly-amended independent claim 11 also includes “a memory for storing the digital contents information outputted from and inputted to the dedicated storage.”

Applicant respectfully submits that “digital information” in the previous version of independent claim 11 has been changed to “digital contents information.” Also, “user” has been changed to “contents user.” Even further, the addition of the newly-described “memory for storing the digital contents information outputted from and inputted to the dedicated storage” as a part of the user device of claim 11 is supported, for example, by page 22, lines 3-6 of the instant application’s specification which teaches “*The checked out contents are recorded in the storage*

*30 of the user device 20, so that adding necessary operations to the operation panel 24 enables the contents to be replayed from the replay unit.”*

Also in this regard, page 23, line 31 – page 24, line 1 of the instant application’s specification goes on to teach that *“On the other hand, using the client function of the mobile type of user device 20 enables a user to checkin the contents, which were checked out toward the user device 20 in the past, into the storage 62 of the storage server 60.”*

Applicant respectfully submits that the terminology “digital contents information” is described in newly-amended independent claim 11 in order to clarify that what interacts with the user device in the embodiments of the disclosure of the instant application is in fact digital content information that is ready to enjoy.

In the Kaplan reference, on the other hand, Applicant respectfully submits that what is dealt appears to be a thesis in light of the disclosure that it is originally held by a “Publisher.” However, Applicant respectfully submits that in the present invention, songs, videos and the like may be included in “digital contents information.” Although the thesis can be dealt with in the system disclosed in Kaplan, Applicant respectfully submits that one having skill in the art of the instant application would not be motivated to apply Kaplan’s disclosed “thesis,” associated with a campus library system, to the present invention, as asserted by the Office Action.

In addition, Applicant respectfully submits that, in Kaplan, the term “Publisher” designates a copyright holder or licensee. This is because the disclosed “Publisher” sells his public key to a user to enable the utilization of his thesis or the like. However, in embodiments of the disclosure of the instant application, as described in newly-amended independent claim 11, the “user device” is a user of a copyright. Accordingly, Kaplan’s disclosed “Publisher” is on a supplier side and the “user device” of the instant application’s claim 11 is on a user side. In order to clarify this relation even further, Applicant has changed “user” in independent claim 11 to “contents user.” As the result of these clarifying amendments, Applicant respectfully submits

that the combination of features described in newly-amended independent claim 11 are clearly distinguished from the disclosure of Kaplan because Kaplan does not disclose, or even suggest, a structural element that corresponds to the “user device,” as specifically described in newly-amended independent claim 11 of the instant application.

Even further, Applicant respectfully submits that in embodiments of the disclosure of the instant application, the user device is configured to communicate with a storage server in order to send or receive digital contents. In order to clarify this feature, newly-amended independent claim 11 now describes that the user device of the claim specifically includes “a memory for storing the digital contents information outputted from and inputted to the dedicated storage” as a constitutional element of the user device.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. § 103(a) should be withdrawn because neither of Stefik and Kaplan, whether taken separately or in combination, teaches or suggests each feature of newly-amended independent claim 11.

MPEP § 2143.03 instructs that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).” Furthermore, Applicant respectfully asserts that the dependent claims are allowable at least because of their dependence from claim 11, and the reasons set forth above.

**Applicant Questions the Applicability of the Kaplan Reference as Prior Art**

Applicant respectfully submits that they have attempted to access the applied Kaplan reference on the Internet without success. Applicant has concluded that Kaplan is no longer available on the Internet. As a result, Applicant respectfully requests that the Examiner inform Applicant of the USPTO's official policy on whether this reference can still be applied in such an instance. Additionally, Applicant respectfully submits that while Kaplan lists a copyright date of December 30, 1996, it also has an apparent publication date of November 16, 2005 (as evidenced by the date in the lower right portion of each page of the document).

Accordingly, Applicant respectfully requests that the Examiner clarify which of these two dates the USPTO is relying on to apply Kaplan as prior art against the instant application. In the event that the USPTO is relying on the earlier December 30, 1996 date, Applicant requests the Examiner to specifically explain how this date can be applied in light of the fact that there is no indication that Kaplan was published, or otherwise publicly available, as of the December 30, 1996 date. In particular, Applicant respectfully submits that there is no specific information provided on the Kaplan document to indicate that the document was publicly available before the priority date of February 16, 2001 of the instant application.

Applicant respectfully submits that the final sentence of 37 C.F.R. § 1.104 (d)(1), reproduced in MPEP § 707.05 directs that "[i]f printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given." In this instance, Applicant respectfully submits that the cited Kaplan document does not indicate a "place of publication" or the "place where a copy can be found" because the document is not available at the indicated website address listed on the document.

Accordingly, Applicant respectfully requests withdrawal of Kaplan as prior art for at least the foregoing reasons. If Kaplan is not withdrawn in the next Office Communication, the Examiner is requested to provide Applicant with a detailed response as to how Kaplan can still be applied as prior art against the instant application in light of the foregoing issues.

While Applicant hopes to receive responses from the Examiner that are supportive of Applicant's desire to remove Kaplan as prior art against the instant application, Applicant notes for the record that, regardless of the Examiner's responses in this regard, Applicant is hereby preserving these issues in the event that Applicant might choose in the future to resolve these issues on appeal if necessary.

### **CONCLUSION**

In view of the foregoing discussion, Applicant respectfully requests the entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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Dated: March 23, 2007

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